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EXAMINER

OGDEN JR, NECHOLUS

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/787,142
Filing Date: February 27, 2004
Appellant(s): KRAMER ET AL.

MAILED
JUL 20 2007
GROUP 1700

Bruce E. Kramer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 28th, 2007 appealing from the Office action mailed July 31st, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24, 26, 28-51, 53-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnenberg et al (6,673,756).

Sonnenberg et al disclose a multiphase soap comprising two or more phases wherein each phase may be opaque and/or comprise different color(s) or dye(s) (col. 21, lines 60-64; col. 26, lines 30-35 and claims 1-5). Sonnenberg et al further teach that said multiphase soap bar comprises an antibacterial components (col. 15, lines 14-42) and further teach that said bar comprises an object for advertising purposes such as a toy of gold or similar materials (col. 21, lines 50-col. 22, line 16).

Sonnenberg et al do not teach with sufficient specificity to anticipate the claims comprising each of the colors in specific layers.

It would have been obvious to one of ordinary skill in the art to disperse the various colors in a specific layers as claimed because Sonnenberg et al teach a multiphase soap bar having two or more phases in different colors (col. 26, lines 30-35). Moreover, one of ordinary skill would have been motivated to comprise a soap bar with a variety of colors for aesthetic reasons or for advertisement considerations. Accordingly, one of ordinary skill in the art would construe specific colors or layers as matters relating to ornamentation or aesthetic design changes which have no mechanical function and therefore cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)

(10) Response to Argument

Appellant argues that the inside layer of claimed invention **is not** visible from the outside and therefore distinguishes itself from the Sonnenberg et al reference.

The examiner contends that applicant's claims do not state that the inside layer is not visible, but that the outside layer is a different color than at least one inside layer (see claim 24). Therefore, the argument with respect to visibility is not well founded since one inside layer can be different but other inside layers may be the same as the outside layer. Moreover, appellant does not have support for his assertion of the visibility of the inside layer in his specification. Accordingly, the skilled artisan would have been able to arrange a variety of different colors of the soap bar of Sonnenberg et al for aesthetic or commercial purposes since Sonnenberg et al teach bars with a plurality of layers and colors (col. 26, lines 30-35).

Appellant argues that Sonnenberg et al do not teach or suggest a step of washing or bathing with a cleansing bar so that the outside, top or first layer(s) "disappear".

The examiner contends that this step would have been obvious to the skilled artisan since washing with a soap bar inherently removes the outer layer due to the friction of rubbing the soap bar on the users skin or cloth, thereby dissolving or "disappearing" the outer or top layer.

Appellant argues that the soap bars of Sonnenberg et al do not motivate a child to wash and improve their hygiene by providing a bar with rainbow colors and a prize identifier such as a pot of gold as recited in claim 58.

The examiner contends and respectfully disagrees because the prior art of record, Sonnenberg et al teach bars with a variety of colors and layers and one skilled in the art would have been motivated to assemble the layers and colors as claimed for aesthetic or commercial purposes, absent a showing to the contrary. With respect to motivating a child to wash, the examiner contends that this would be an inherent property of the soap bars because as Sonnenberg et al teach layered soap bars with a plurality of colors in a variety of arrangements and formulated with surfactants, one skilled in the art would expect said soap bars to used for the inherent purpose of motivating any human, and including a child, to wash or bathe with said bar. With respect to improving a child's hygiene, the examiner contends that the soap bars have cleansing phases, which would clean and improve the hygiene of a child if used as a cleansing personal soap bar as suggested by Sonnenberg et al. With respect to the prize identifier or pot of gold, Sonnenberg et al teach that said bar comprises an object for advertising purposes such as a toy of gold or similar materials (col. 21, lines 50-col. 22, line 16). Accordingly, the courts held that reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991) "it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar

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utility as one newly discovered by applicant," and concluded that here a prima facie case was established because "[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties."

Appellant argues that Sonnenberg et al do not teach or suggest a soap bar comprised of layers and colors.

The examiner contends that Sonnenberg et al specifically teach that said bars comprise a plurality of phases (or layers) and a varied combination of colors (col. 21, lines 60-64; col. 26, lines 30-35 and claims 1-5). Therefore, Sonnenberg et al specifically suggest different colored phases as suggested by the claimed invention. With respect the different color, the examiner contends that said color(s) are within the level of artisan having ordinary skill and would have been obvious to select specific colors for commercial purposes. Again, specific colors or layers have been held that matters relating to ornamentation or aesthetic design changes which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art *In re Seid* , 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Appellant argues that the Seid case law is related to a product and the claims of the present invention are related to a method. Moreover, appellant states that "the colors or layers....are not merely ornamentation or aesthetic design changes, but are rather functional in that they are specifically designed to motivate a child to wash or bathe."

The examiner contends that appellant states that the colors or layer are designed to motivate a child to wash or bathe. Therefore, the examiner contends, the layers and

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colors are designed and designated to perform an inherent property that does not require any specific mechanical function, but their sole purpose is related to the compositional arrangement of the soap bar. Appellant is including colors and layers for their aesthetic design or "specifically designed" for their intended purpose and one skilled in the art would have been motivated to include a variety of colors or layers for their purpose, the implementation of aesthetic designs for motivating use of said bar, which is held obvious in view of *In re Seid*.

Appellant further argues that *In re Linter* and *In re Dillon* case law do not apply.

The examiner respectfully disagrees because *In re Linter* and *In re Dillon* relate to solving a different problem or having a similar composition provides motivation for similar properties. These two cases relate to appellants arguments that the motivation to make a child wash or bathe is a factor that is not necessary when the prior art solves or is related to a different problem, as long as the prior is analogous art. *In re Linter* establishes the precedent that similar compositions are expected to have the same or similar properties. Therefore, these two cases cited provide legal precedence for sustaining the obviousness rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Necholus Ogden, Jr./

Necholus Ogden, Jr.

Conferees:

Douglas McGinty



Greg Mills

